

UNITED STATE DEPARTMENT OF COMMERCE Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO. 09/421,490 10/20/99 ROLLHAUS 903.0001USV **EXAMINER** WM02/0131 HARRY F SMITH ESQ DAVIS. D **ART UNIT** PAPER NUMBER OHLANDT GREELEY REGGIERO & PERLE LLP ONE LANDMARK SQUARE 9TH FLOOR 2652 STAMFORD CT 06901-2682 **DATE MAILED:** 01/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<u>. L</u>		Application No.	Applicant(s)	
•	•	Application No.	Applicant(s)	
Office Action Summary		09/421,490	ROLLHAUS ET AL.	
		Examiner	Art Unit	
		David D. Davis	2652	
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply				
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status				
1)🖂	Responsive to communication(s) filed on 14	November 2000 .		
2a)	This action is FINAL . 2b)⊠ Th	nis action is non-final.		
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
Disposition of Claims				
4) 🖂	4) Claim(s) 1-7,15 and 22-26 is/are pending in the application.			
	4a) Of the above claim(s) <u>1-7</u> is/are withdrawn from consideration.			
5)⊠ Claim(s) <u>22-26</u> is/are allowed.				
6)⊠ Claim(s) <u>15</u> is/are rejected.				
7)	7) Claim(s) is/are objected to.			
8) Claims are subject to restriction and/or election requirement.				
Application Papers				
9)⊠ The specification is objected to by the Examiner.				
10) The drawing(s) filed on is/are objected to by the Examiner.				
11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.				
12) The oath or declaration is objected to by the Examiner.				
Priority under 35 U.S.C. § 119				
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).				
a) ☐ All b) ☐ Some * c) ☐ None of:				
1. Certified copies of the priority documents have been received.				
2. Certified copies of the priority documents have been received in Application No				
3. Copies of the certified copies of the priority documents have been received in this National Stage				
application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.				
14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).				
7.10 / tokilowicage mane of a claim for asmostic phony analy of claim (c).				
Attachment(s)				
15) ☑ Notice of References Cited (PTO-892) 16) ☑ Notice of Draftsperson's Patent Drawing Review (PTO-948) 17) ☑ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8 18) ☐ Interview Summary (PTO-413) Paper No(s) ☐ Notice of Informal Patent Application (PTO-152) 20) ☐ Other:				

Election/Restrictions

1. Applicant's election of Species IX, figure 12 and Subspecies III, figure 3, claims 15 and 22-26 in Paper No. 7, received November 14, 2000 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

Receipt is acknowledged of the Information Disclosure Statement (IDS) received October
 1999.

Specification

3. The disclosure is objected to because of the following informalities: On page 1 "This is a division of application serial no. 08/902,844, filed July 30, 1997" should be --This is a division of application serial no. 08/902,844, filed July 30, 1997, now U.S. Patent 6,011,772--

Appropriate correction is required.

Double Patenting

4. Claim 15 is rejected under the judicially created doctrine of double patenting over claim 13 of U. S. Patent No. 6,011,722 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter,

Application/Control Number: 09/421,490

Art Unit: 2652

as follows: providing an optical disc having machine-readable, information-encoding features, and a reading-inhibit agent; providing a reading device including a source of optical radiation; reading the disc with the reading device.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

- 5. Claims 22-26 are allowable over the prior art of record.
- 6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is (703) 308-1503. The examiner can normally be reached on Mon., Tues., Thurs. and Fri. between 7:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9052 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

David D. Davis
Primary Examiner
Art Unit 2652

ddd January 28, 2001